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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/719,422 | 12/12/2000 | Yoshihisa Furuta | Q 62228 | 7788 |

7590 09/16/2005

Sughrue Mion Zinn
Macpeak & Seas
2100 Pennsylvania Avenue NW
Washington, DC 20037

EXAMINER

MUSSER, BARBARA J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1733

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/719,422

Applicant(s)

FURUTA ET AL.

Examiner

Barbara J. Musser

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2 and 6-19.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) _____.
13. ☐ Other: _____.


SAM CHUAN YAO
PATENT EXAMINER

Continuation of 3. NOTE: The addition of heating of the adhesive to 180C would require further search and/or consideration..

ATTACHMENT

Regarding applicant's argument as to the adhesive strength after heating, applicant is referring to limitations not entered in the claims. Currently the claims do not require any heating step, only requiring a specific characteristic of the adhesive when heated, and the claim adhesive strength currently reads on zero adhesive strength when the adhesive is heated.

Regarding applicant's argument that the adhesive of Senoo is not adhesive at 180C and therefore could not be combined, the adhesive is of the same type as applicant's, namely a silicone resin. Absent evidence that the resin loses its adhesiveness at high temperatures, the adhesive is considered to act the same as applicant's, namely that it is an adhesive at 180C.

Regarding applicant's argument that the range and units of the adhesive strength of Senoo are different from applicant's the range is within applicant's, and the difference in units can be easily converted between. An adhesive strength of less than 300 gf/25 mm is an adhesive force of less than 240 gf/20 mm. A division by 25 gives the adhesive strength per mm, and a multiplication by 20 gives the adhesive strength per 20 mm. It is noted that applicant misread the adhesive strength units of Senoo, as they are per 25 mm, not 25 cm.(Col. 4, ll. 65).

Regarding applicant's argument that the examples show the adhesive strength is not the same when heated as at 23C, examiner was stating that absent evidence to the contrary, the adhesive strength of the adhesive of Senoo after heating and cooling was considered to be the same or less than that before heating and cooling since the

Art Unit: 1733

adhesive is the same type as applicant's, namely a silicone adhesive. The claims require the adhesive strength at 23C to be 400 gf/20 mm or less, not that the adhesive strength at 180C be in that range. Even if the adhesive strength of the adhesive of Senoo increased at 180C, so long as it reverted to approximately its initial strength or less at 23C it would meet the claim limitations, since the claim measures the adhesive strength at 23C, not 180C. If applicant believes the adhesive of Senoo would either not be adhesive at 180 or would have an increased adhesive strength in excess of applicant's range after heating to 108C and cooling, it is suggested that a declaration showing such be filed.

Regarding applicant's argument that the low adhesive strength is required to easily remove the tape from the frame, Senoo clearly shows that a low adhesive strength is desired in the electronic arts so that the adhesive can hold parts securely and yet can be peeled off without any adhesive transferring to the article to which the adhesive was applied. One in the art would use this type of adhesive where these characteristics were desired such as to hold chips in place while coating them with resin.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on (571)-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJM



SAM CHUAN YAO
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